



14 December 2012

OFFICE ORDER NO. 289  
Series of 2012

**Subject: IMPLEMENTATION OF IPOP HL- USPTO PATENT PROSECUTION  
HIGHWAY**

The Intellectual Property Office of the Philippines (IPOP HL) – United States Patent and Trademark Office (USPTO) Patent Prosecution Highway (PPH) on work sharing signed on October 4, 2012 will take effect on January 1, 2013.

Applications to be prosecuted under the PPH shall be subject to the guidelines herein attached as Annex A.

Applicants and agents who wish to avail of the PPH shall duly accomplish the PPH Request Form herein attached as Annex B, and seasonably file the same.

Under the IPOP HL- USPTO PPH Agreement, IPOP HL applications with corresponding USPTO applications shall be given priority by means of an advanced-out-of-turn examination. Furthermore, USPTO work products shall serve as additional reference by the IPOP HL Examiners.

For guidance.

**ATTY. RICARDO R. BLANCAFLOR**  
Director General

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**Revised Requirements for the Patent Prosecution Highway Program between the United States Patent and Trademark Office and the Intellectual Property Office of the Philippines**

**I. Background**

The United States Patent and Trademark Office (USPTO) has established a 2010-2015 Strategic Plan to transform the USPTO into a more quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system. One of the specific action items of the 2010-2015 Strategic Plan is to share search results with other intellectual property offices. By relying on the search results obtained via partnerships with other intellectual property offices, the USPTO can reduce duplication of efforts and decrease workload.

From July 2006 to January 2008, the USPTO partnered with the Japan Patent Office (JPO) to establish the first Patent Prosecution Highway (PPH) pilot program. The PPH leverages accelerated examination procedures already available in both offices to allow applicants in both offices to obtain corresponding patents faster and more efficiently. The PPH also permits each office to benefit from the work previously done by the other office, in turn helping to reduce workload and improve patent quality. The USPTO and the JPO began full implementation of the PPH program starting January 4, 2008.

The USPTO commenced a PPH pilot program with the Korean Intellectual Property Office (KIPO) and the Canadian Intellectual Property Office (CIPO) on January 28, 2008. The pilot program with KIPO ended on January 28, 2009, and full implementation of the PPH program began on January 29, 2009. The pilot program with CIPO ended on January 28, 2011, and full implementation of the PPH program began on January 29, 2011.

USPTO has also commenced separate PPH pilot program with the United Kingdom Intellectual Property Office (UKIPO), IP Australia (IPAU), the European Patent Office (EPO), the Danish Patent and Trademark Office (DKPTO), the Intellectual Property Office of Singapore (IPOS), the German Patent and Trade Mark Office (DPMA), the National Board of Patents and Registration of Finland (NBPR), the Hungarian Patent Office (HPO), the Russian Patent Office (Rospatent), the Austrian Patent Office (APO), the Spanish Patent and Trademark Office (SPTO), the Mexican Institute of Industrial Property (IMPI), the Israeli Patent Office (ILPO), the Taiwan

Intellectual Property Office (TIPO), the Norwegian Industrial Property Office (NIPO), the State Intellectual Property Office of the People's Republic of China (SIPO), and the Icelandic Patent Office (IPO) based on the same or similar framework as the PPH between the USPTO and JPO.

Following on these partnerships, the USPTO and the Intellectual Property Office of the Philippines (IPOPIL) have agreed to launch a PPH pilot program similar to the PPH pilot programs noted above.

## **II. Patent Prosecution Highway Pilot Program**

The PPH was established to enable an applicant whose claims are determined to be allowable/patentable in the Office of First Filing (OFF) to have the corresponding application filed in the Office of Second Filing (OSF) advanced out of turn for examination while at the same time allowing the OSF to exploit the search and examination results of the OFF.

Where the USPTO is the OFF and the US application claims that there are determined to be allowable/patentable, the applicant may request accelerated examination at the IPOPIL for the corresponding application filed with the IPOPIL as the OSF. The procedures and requirements for filing a request with the IPOPIL for participation in the PPH pilot program will be available on [insert date], from the IPOPIL Web site at: <http://www.ipophil.gov.ph/>.

Where the USPTO is the OSF and the corresponding application filed with the IPOPIL as the OFF contains claims that are determined by the IPOPIL to be allowable/patentable in a substantive examination carried out in the name of the IPOPIL, the applicant may request participation in the PPH pilot program in the USPTO and request that the US application be advanced out of turn for examination by order of the Director to expedite the business of the Office under 37 CFR 1.102(a). Note that the procedures for a petition to make special under the accelerated examination program set forth in MPEP 708.02(a) do NOT apply to a request for expedited examination by order of the Director to expedite the business of the Office under 37 CFR 1.102(a). The procedures and requirements for filing a request in the USPTO for participation in the PPH pilot program are set forth below.

### **A. Trial Period for the PPH Program**

The PPH Pilot Program will commence on January 1, 2013 for a period of one (1) year ending on December 31, 2013. The trial period may be extended for up to an additional year if necessary to adequately assess the feasibility of the PPH Program. The USPTO and the IPOPHIL will evaluate the results of the Pilot Program to determine whether and how the program should be fully implemented after the trial period. The offices may also terminate the PPH Pilot Program early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published if the PPH Pilot Program will be terminated before the December 31, 2013 date.

### **United States Patent and Trademark Office as the Office of First Filing Intellectual Property Office of the Philippines as the Office of Second Filing**

#### **I. Requirements for Requesting Participation in the PPH Pilot Program in the IPOPHIL**

In order to be eligible to participate in the PPH Pilot Program, the following conditions must be met:

- (1) The IPOPHIL application for which participation in the PPH program is requested and the corresponding USPTO application must have the same priority date.
  - i) An application that validly claims priority (ANNEX Figures A,B,C and D);
  - ii) An application which is the basis of a valid priority claim under the Paris Convention for the application filed with IPOPHIL (Annex Figures E, F and G);
  - iii) An application which shares a common priority document with the application files in IPOPHIL (Annex Figures H, I, J, K and L;
  - iv) IPOPHIL application derived from/ related to a PCT application having no priority claim (Annex Figure M).

Provisional applications, plant applications, design applications, reissue applications, re-examination proceedings and applications subject to a secrecy order are excluded and not subject to participation in the PPH.

- (2) At least one (1) claim was determined by USPTO to be allowable/patentable. The applicant must submit a copy of the allowable/patentable claims from the USPTO application. If the USPTO office action does not explicitly state that a particular claim is allowable, the applicant must include a statement in the request for participation in the PPH program or in the transmittal letter accompanying the request for participation that no rejection has been made in the USPTO office action regarding that claim, and therefore, the claim is deemed to be allowable by the USPTO.
  
- (3) All claims on file, as originally- filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the USPTO. Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the IPOPHIL are of the same or similar scope as the claims in the USPTO. In this regard, a claim that is narrower in scope occurs when a USPTO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). A claim in the IPOPHIL which introduces a new/different category of claims to those claims indicated as allowable in the USPTO is not considered to sufficiently correspond. For example, if the USPTO claims only contain claims to a process of manufacturing a product, then the claims in the IPOPHIL are not considered to sufficiently correspond if the IPOPHIL claims introduce product claims that are dependent on the corresponding process claims.

The additional limitation that makes the claims in the PH application narrower in scope than the allowable/patentable claims in the USPTO application must have support in the written description of the PH application and the additional limitation must be presented in dependent form. The applicant is required to submit a claims correspondence table. The claims correspondence table must indicate how all the claims in the PH application correspond to the allowable/patentable claims in the USPTO application/s. The dependent claims with the additional limitations must be clearly identified in the claims correspondence table.

- (4) Examination of the PH application for which participation in the PPH program is requested has not begun.

- (5) The applicant must file a request for participation in the PPH program and a request that the PH application be advanced out of turn for examination by order of the Director. *Provided*, That a Request for Early Publication pursuant to Rule 800.1 of the Implementing Rules and Regulations for Patents, as amended will be submitted for Direct Route applications. *Provided, further*, That this rule shall only apply to the first two- hundred (200) PPH applications annually which will be divided to one hundred (100) applications per semester to maintain manageable levels.

The maximum number of PPH applications to be considered shall be reviewed annually and may be modified based on the number of filings, number of examiners and etc.

- (6) The applicant must submit a copy of the office action from the USPTO application just prior to the "Decision to Grant a Patent" (e.g. the latest "Notification for Reasons for Refusal") from each of the USPTO application(s) containing the allowable/ patentable claims that are the basis for the request. It will not be necessary for applicant to submit a copy of the "Decision to Grant a Patent." If the USPTO application is a first action allowance, i.e., there is no office action just prior to the "Decision to Grant a Patent," then applicant should indicate on the request form that no office action from the USPTO application is submitted since the USPTO application was a first action allowance.

The applicant must submit copies of any office actions (which are relevant to patentability) from the USPTO application(s) issued after the grant of the request for participation in the PPH program in the IPOPHIL (especially where USPTO might have reversed prior holding of allowability).

- (7) The applicant must submit an information disclosure statement (IDS) listing the documents cited by the USPTO examiner in the USPTO office action (unless such IDS has already been filed in the IPOPHIL application). The applicant must submit copies of all the documents cited in the USPTO office action (unless the copies have already been filed in the PH application) except PH patents or PH patent application publications.

The request for participation in the PPH program and all the supporting documents must be submitted to the IPOPHIL.

Where the request for participation in the PPH program and special status are granted, the applicant will be notified and the PH application will be advanced out of turn for examination. In those instances where the request for participation in the PPH program does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given one opportunity to perfect the request in a renewed request for participation. Note that action on the application by the examiner will NOT be suspended awaiting a reply by the applicant to perfect the request in a renewed request for participation. That is, if the application is picked up for examination by the examiner after the applicant has been notified of the defects in the request, any renewed request will be dismissed. If the renewed request is perfected and examination has not begun, the request and special status will be granted, the applicant will be notified and the PH application will be advanced out of turn for examination. If not perfected, the applicant will be notified and the application will await action in its regular turn.

- (8) Request for participation in the PPH program and special status granted in a parent application will not carry over to divisional application(s). The applicant must fulfil all the conditions set forth above in order for special status to be granted in the divisional application.

The Manual for Substantive Examination Procedure, as amended, defines divisional application as a non- elected application which is not elected after a requirement for restriction and can be subject of a new application. Rule 604 (b) of the Implementing Rules and Regulations on Inventions, as amended further provides that a later application filed for an invention divided out shall be considered as having been filed on the same day as the first application.

If any of the documents identified in items (2), (6) and (7) above have already been filed in the PH application prior to the request for participation in the PPH program, it will not be necessary for the applicant to resubmit these documents with the request for participation. The applicant may simply refer to these documents and

indicate in the request for participation in the PPH program when these documents were previously filed in the PPH application.

## **II. Special Examining Procedures**

Once the request for participation in the PPH program and special status have been granted to the PH application, the PH application will be taken up for examination by the PH examiner before all categories of application except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination." *Provided*, That such applications make it to the first one hundred (100) PPH applications per semester.

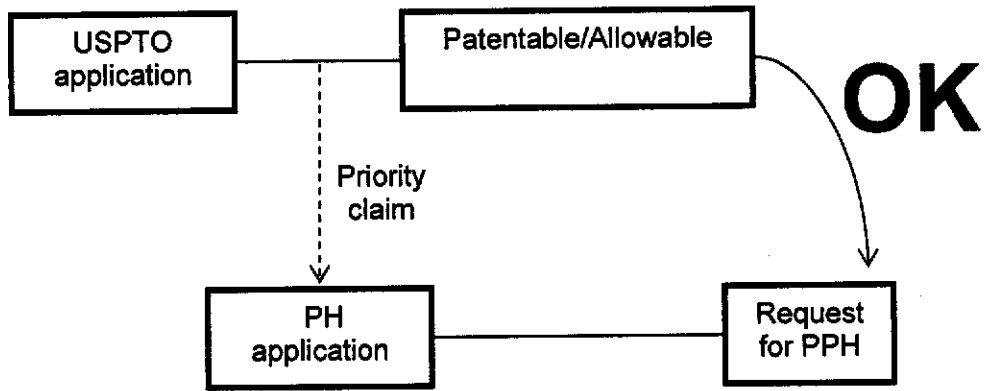
Any claims amended or added after the grant of the request for participation in the PPH program must sufficiently correspond to one or more allowable/patentable claims in the USPTO application(s). The applicant is required to submit a claims correspondence table along with the amendment. If the amended or newly-added claims do not sufficiently correspond to the allowable/patentable claims in the USPTO application(s), the amendment will not be entered and will be treated as a non-responsive reply.



ANNEX

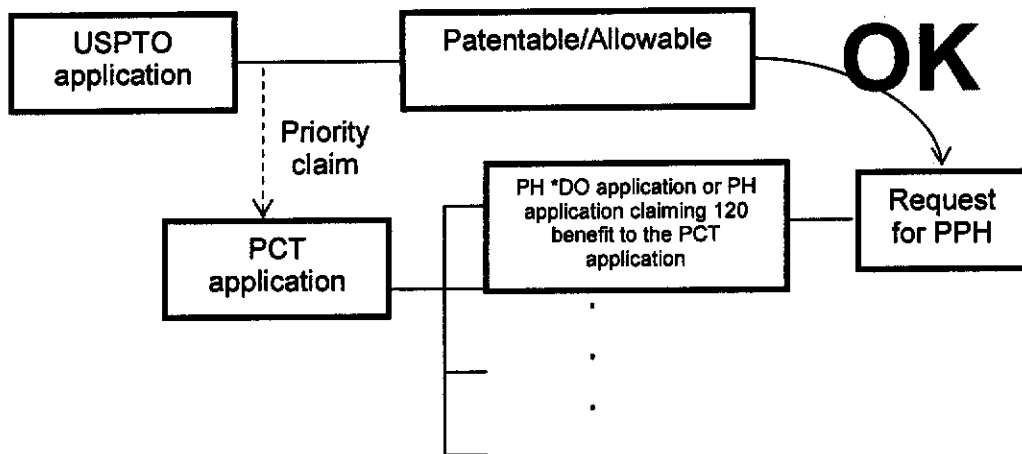
(A)

(Case I)  
- Paris route -



(B)

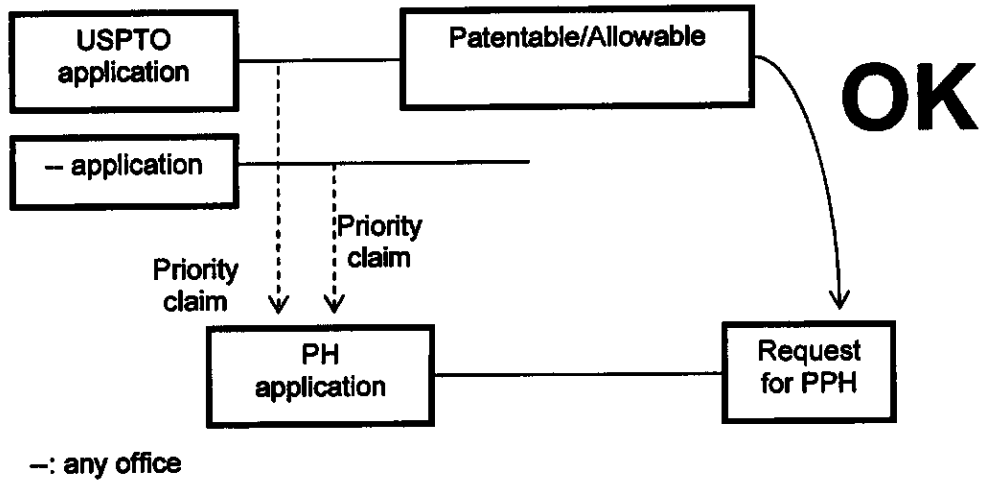
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- PCT route -



\*DO - designated office

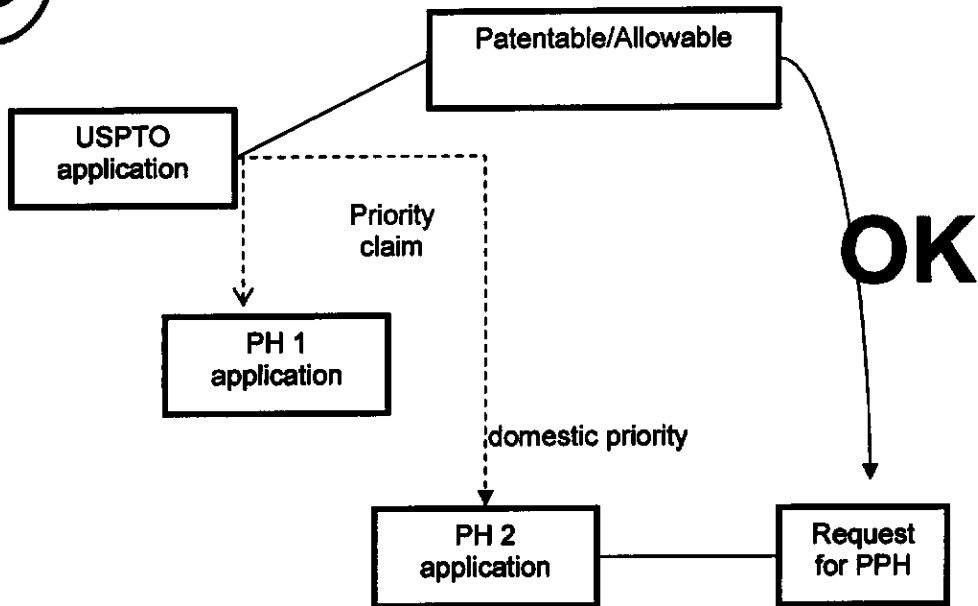
(C)

(Case I)  
- Paris route & Complex priority -



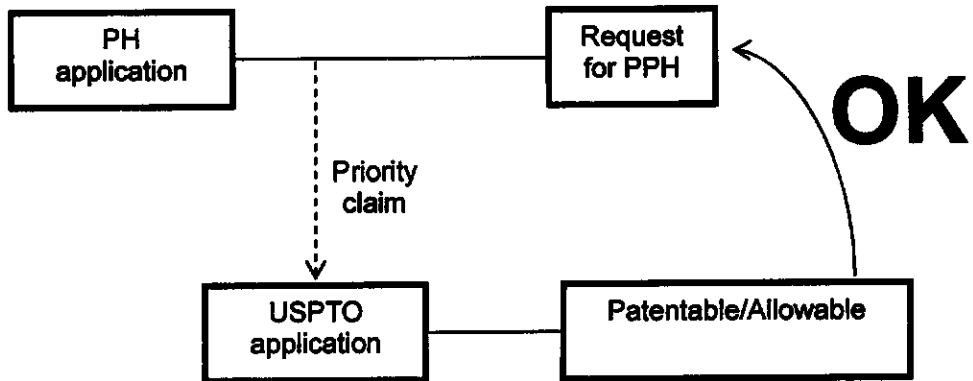
(D)

(Case I)  
- Paris route & divisional application =



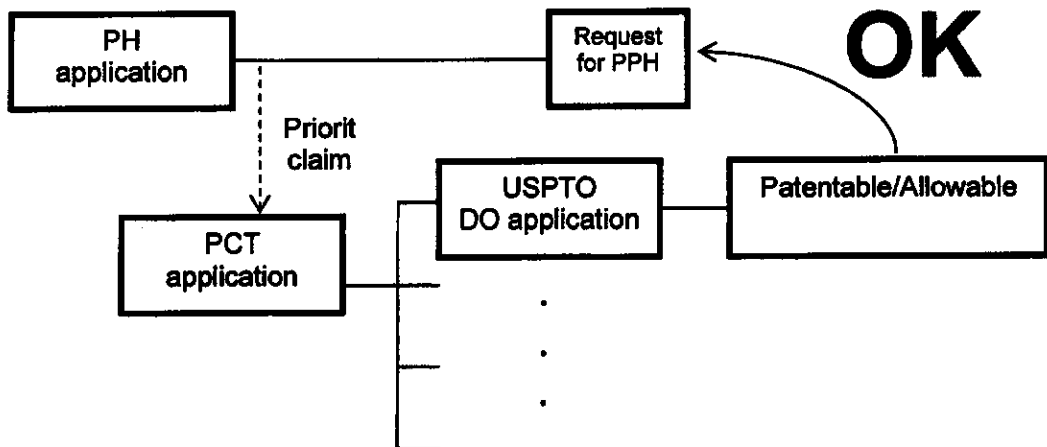
**E**

(Case II)  
- Paris route -



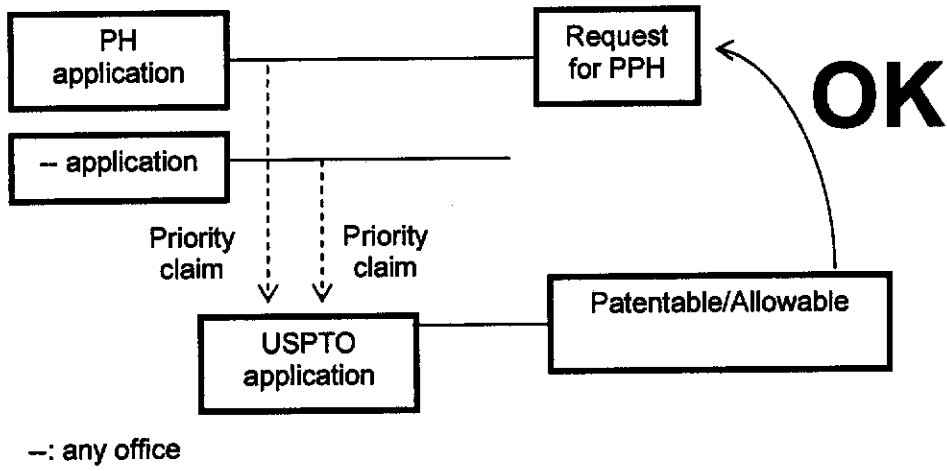
**F**

(Case II)  
- PCT route -



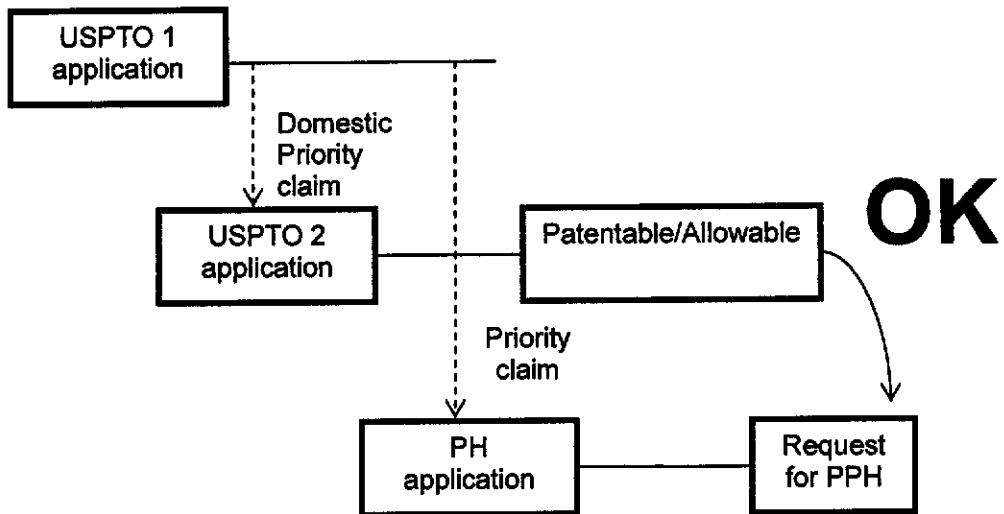
**G**

(Case II)  
- Paris route & Complex priority -



**H**

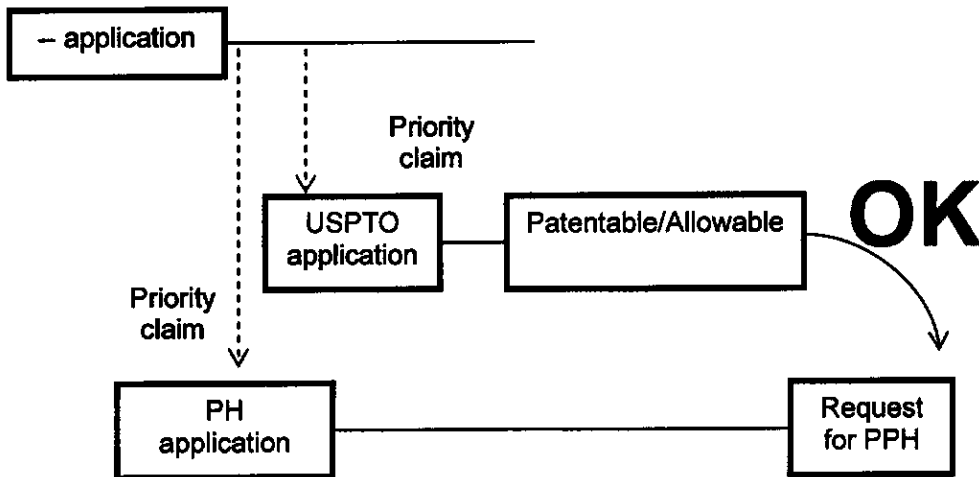
(Case III)  
- Paris route, Domestic priority -



(Case III)

- Paris route, but the first application is from the third country -

I

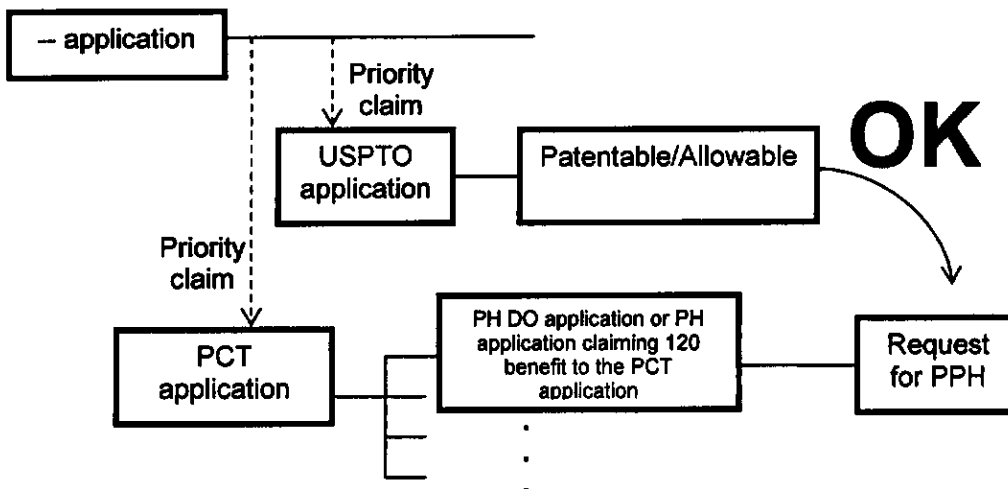


--: an office other than the JPO and the USPTO

(Case III)

- PCT route, but the first application is from the third country -

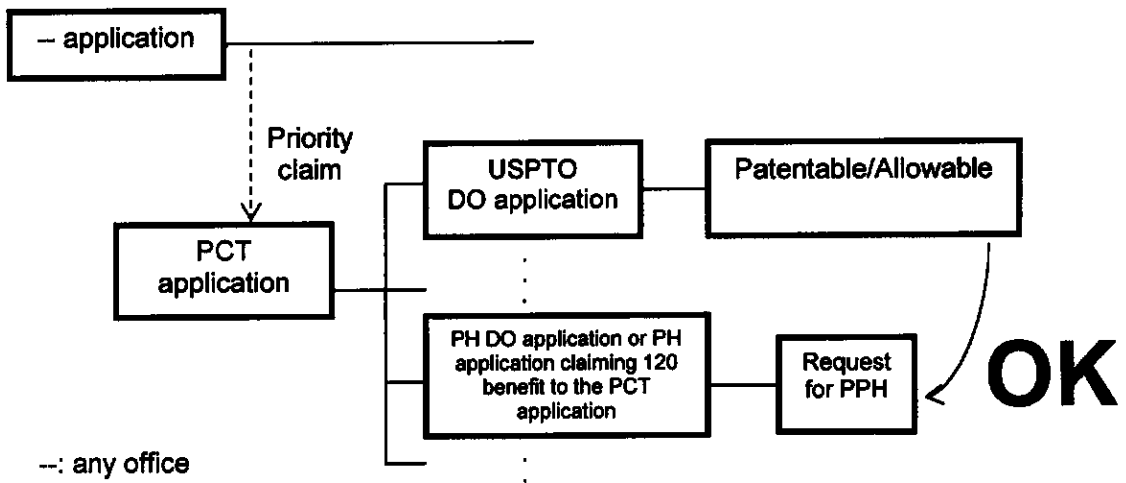
J



--: an office other than the JPO and the USPTO

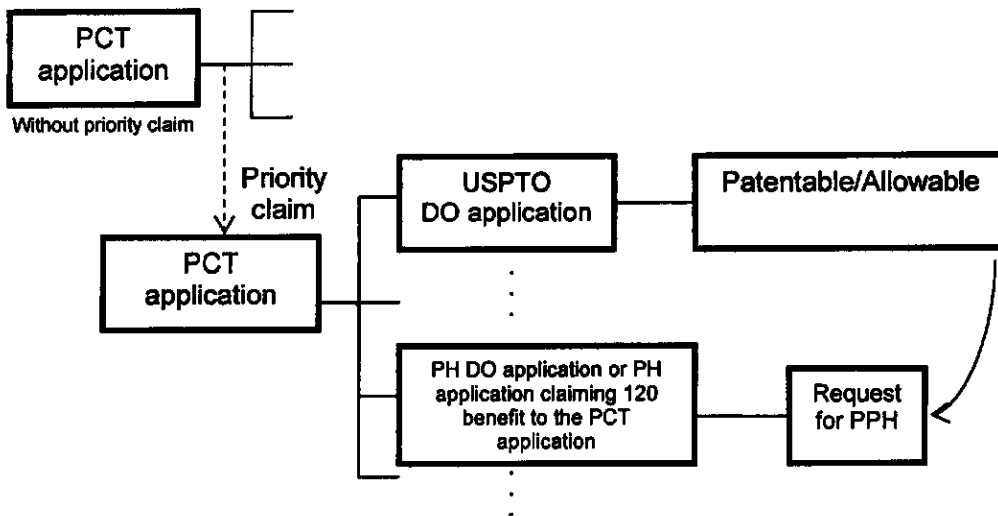
(K)

(Case III)  
- PCT route -



(L)

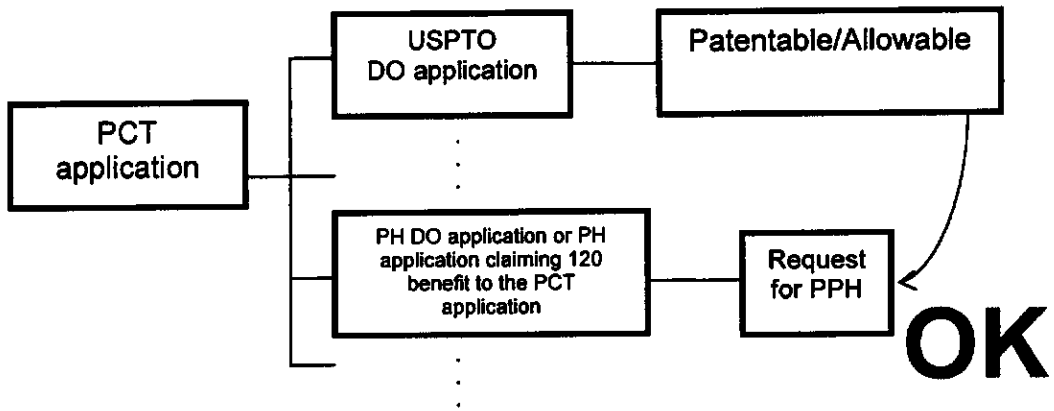
(Case III)  
- Direct PCT & PCT route -



13

M

(Case IV)  
- Direct PCT route -



## **Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the Intellectual Property Office of the Philippines based on Patent Cooperation Treaty Work Products**

### **I. Background**

Since 2006, the United States Patent and Trademark Office (USPTO) has established Patent Prosecution Highway (PPH) pilot programs with several Offices. In general, such PPH pilot programs permit an applicant who receives a determination from one office that at least one claim is allowable/patentable to request that a corresponding application in another office be accorded special status and advanced out of turn for examination. These PPH pilot programs are limited to the utilization of search and examination results of national applications between cross filings under the Paris Convention.

In order to expand the potential of the PPH pilot program, the USPTO recently implemented a new PPH pilot program with our Trilateral partners (the European Patent Office (EPO) and the Japan Patent Office (JPO)), the Korean Intellectual Property Office (KIPO), the Austrian Patent Office (APO), the Federal Service on Intellectual Property, Patents & Trademarks (Rospatent), the Spanish Patent and Trademark Office (SPTO), IP Australia (IPAU), the National Board of Patents and Registration of Finland (NBPR), the Swedish Patent and Registration Office (PRV), the Nordic Patent Institute (NPI), and the State Intellectual Property Office of the People's Republic of China (SIPO) based on Patent Cooperation Treaty (PCT) work products (PCT-PPH pilot program). The USPTO had discussions with the Intellectual Property Office of the Philippines (IPOP) to launch a PCT-PPH pilot program based in part on the PCT-PPH pilot programs identified above. The USPTO and the IPOP agreed that consistency between PCT-PPH pilot programs should be maintained to the extent possible, to avoid creating burdens on applicants and offices, and to ensure maximum work-sharing potential.

### **II. PCT-PPH Pilot Program**

The PCT-PPH pilot program was established to enable an applicant, who has received

- (1) a Written Opinion from the United States International Searching Authority, or
- (2) a Written Opinion from the United States International Preliminary Examining Authority, or
- (3) an International Preliminary Examination Report from the United States International Preliminary Examining Authority,

that indicates at least one claim in the PCT application has novelty, inventive step and industrial applicability, to file a request to participate in the PCT-PPH pilot program and request accelerated examination for the corresponding application filed with the IPOP. The procedures and requirements for filing a request in the IPOP for participation in the



PCT-PPH pilot program will be available on [insert date] from the IPOPH Web site at: <http://www.ipophil.gov.ph/>.

**Trial Period for the PCT-PPH Pilot Program**

USPTO and IPOPH agreed to commence the PCT-PPH pilot program on January 1, 2013 for a period of one year ending on December 31, 2013. The trial period may be extended if necessary until the IPOPH receives a sufficient number of PCT-PPH requests to adequately assess the feasibility of the PCT-PPH pilot program. The USPTO and the IPOPH may also terminate the PCT-PPH pilot program early if the volume of participation exceeds a manageable level, or for any other reasons. Notice will be published if the PCT-PPH pilot program will be terminated before the December 31, 2013.

Any inquiries concerning this notice may be directed to Bryan Lin, Office of PCT Legal Administration at 571-272-3303, or via e-mail addressed to [bryan.lin@uspto.gov](mailto:bryan.lin@uspto.gov).

Specific questions about the Patent Prosecution Highway should be directed to the Office of Petitions at 571-272-3282, or via e-mail addressed to [PPHfeedback@uspto.gov](mailto:PPHfeedback@uspto.gov).

Date: \_\_\_\_\_

\_\_\_\_\_  
David J. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

**USPTO- IPOPHL PATENT PROSECUTION HIGHWAY (PPH) REQUEST FORM**

<b>APPLICATION NO.</b>	
<b>TITLE OF THE INVENTION</b>	
<b>APPLICANT</b>	
<b>CORRESPONDING USPTO APPLICATION NO.</b>	
<b>DOCUMENTS SUBMITTED</b>	<ul style="list-style-type: none"> <li>○ Copies of all office actions</li> <li>○ Copies of all claims determined to be patentable/ allowable by the USPTO</li> <li>○ Information Disclosure Statement (IDS)</li> <li>○ Claim Correspondence Table</li> <li>○ Request for an Advanced-out-of-turn Examination</li> </ul>
<b>SIGNATURE/ DATE</b>	
<i>For authorized receiving officer of IPOPHL only</i>	
<b>RECEIVING OFFICER</b>	
<b>DATE RECEIVED</b>	



